

REMARKS

In the outstanding Office Action dated August 11, 2004, each of pending claims 67-72 and 74-81 were rejected under 35 USC 103(a) as being unpatentable over Martin (US 5,575,817) in view of Martin (US 5,653,743). In rejecting the claims, the Examiner stated that incorporating "elements similar to components 1 and 18 of Martin '743 into the Martin '817 assembly would have been obvious for patients for whom such reconstruction is necessary in view of the discussion at col. 1, lines 24-50 of Martin '743, with further motivation having been provided by the similarities in design and purpose of the two inventions (Martin '817: column 1, lines 12-15 and 32-34; Martin '743: column 1, lines 6-9; column 4, lines 30-33)."

However, it is respectfully submitted that there is no motivation to modify the teachings of the cited '817 patent in view of the cited '743 patent. MPEP 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" and that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." Further, the MPEP states that "The level of skill in the art cannot be relied upon to provide the suggestion to combine the references." Moreover, it is highly significant that MPEP 2143.01 also states that "If the proposed modification or combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."

Significantly, the '817 reference does not contemplate any modifications beyond what is disclosed in its specification nor does it identify any shortcomings or other issues which could be addressed by modifying the device disclosed therein. The '817 patent merely contemplates a first section 1 being attached to a second section 2 and the Examiner has acknowledged that the '817 patent does not recognize nor contemplate the device recited in the claims which includes a body having a first leg longer than a second leg and an extender in the form of a graft configured to mate with the first leg after the body is placed in vasculature. In fact, in the summary of the invention at Column 1, line 55 et seq., the '817 reference teaches measuring by angiography or other appropriate imaging study, the length and diameter of the neck of an aneurysm, the aortic diameter, the length of the aorta from the renal arteries to the bifurcation and the length of the common iliac arteries. Such measurements are said to "determine the appropriate dimensions of the inverted Y graft" and thus, the '817 patent teaches accurately measuring anatomy as the only approach to reconstruction and does not contemplate adding additional components like those of the '743 patent to effect a reconstruction.

Moreover, the '817 patent merely discloses an inverted Y graft prosthesis including two sections, the first section including a partial length of one of two lower limbs and a second section comprising the remainder of the partial lower limb. The '817 patent further states that the inverted Y is completed when the second section is attached to the first section (See Col. 1, ln. 65). Additionally, the '817 reference states that "The completion of the two stage procedure results in the insertion of the inverted Y graft with the upper limb anchored to the aorta above the aneurysm and the lower limbs positioned in the corresponding iliac arteries."

Accordingly, it is in contradiction to the teachings of the '817 patent that it would have been obvious to add components 1 and 18 of the '743 patent to the structure disclosed in the '817

patent to meet the limitations recited in the pending claims. That is, since the '817 patent teaches accurately measuring anatomy prior to completing a two stage procedure within vasculature (outlined above), one of ordinary skill in the art would not read the '817 patent and then conclude that components of the '743 patent should be added. Therefore, it is respectfully submitted that the teachings of the '817 patent would not be modified in view of the of the teachings of the '743 patent as suggested by the Examiner. It is also respectfully submitted that in contradiction with the guidance provided by the MPEP, the '817 and '743 patents have been improperly combined since the '817 patent contains no suggestion or motivation for the combination, the '817 patent does not suggest desirability of the combination, and the Examiner has appeared to have relied upon what the Examiner believes to be the level of skill in the art to provide the suggestion to combine the references.

Specifically with regard to new claim 82, it is respectfully submitted that neither the '817 patent nor the '743 patent teach the recited device. In particular, the '743 teaches an approach involving placing a bifurcated graft in each hypogastric artery "so that the whole of the aorto-iliac segment may then have endovascular straight grafts placed as a means of managing atherosclerotic aorto-iliac disease."

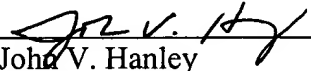
Accordingly, it is respectfully submitted that each of the pending claims are patentable over the cited references.

CONCLUSION

Applicants have attempted to completely respond to the rejections set forth in the outstanding Office action. In view of the above amendments and remarks, Applicants respectfully request that the application be reconsidered, the claims allowed and the application passed to issue.

Respectfully submitted,

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